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PATENT

Attorney Docket No.: A-64558-1/RFT/RMS



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re application of:  
KAYYEM et al.

Serial No. 08/873,597

Filed: June 12, 1997

For: ALTERNATING CURRENT  
METHODS FOR DETECTION  
OF NUCLEIC ACIDS

Examiner: Unknown

Group Art Unit: 1815

97 JUN 28 PM 3:43  
GROUP 100  
EXAMINER: J. L. JONES  
RECEIVED: JUN 28 1997  
U.S. PATENT AND TRADEMARK OFFICE  
CUSTODIAN OF PATENTS

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on January 23, 1998:

Signed:

Margaret B. Joyce

INFORMATION DISCLOSURE STATEMENT  
STATEMENT OF RELATEDNESS

Assistant Commissioner  
for Patents  
Washington, DC 20231

Sir:

In satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and in accordance with the provisions of 37 C.F.R. §§ 1.97 and 1.98, Applicants wish to draw the attention of the U.S. Patent and Trademark Office to the references cited on the accompanying form PTO-1449. Copies of the references are enclosed.

With respect to patent applications, the applicants point out their duty under M.P.E.P. §2001.06(b) to disclose relevant patent applications of which they are aware. To

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**Filed: June 12, 1997**

this end, the applicants draw the Examiner's attention to the following patent applications also enclosed herewith:

1. U.S.S.N. 08/475,051, filed June 7, 1995, Meade et al., entitled "Nucleic Acid Mediated Electron Transfer."
2. U.S.S.N. 08/660,534, filed June 7, 1996, Meade et al., entitled "Nucleic Acid Mediated Electron Transfer."
3. U.S.S.N. 08/659,987, filed June 7, 1996, Meade et al., entitled "Nucleic Acid Mediated Electron Transfer."
4. U.S.S.N. 08/873,598, filed June 12, 1997, Meade et al., entitled "Nucleic Acid Mediated Electron Transfer."
5. U.S.S.N. 08/786,187, filed January 21, 1997, Bamdad et al., entitled "Molecular Recognition at Surfaces Derivatized with Self-Assembled Monolayers."
6. U.S.S.N. 08/843,623, filed January 21, 1997, Bamdad, entitled "Surface-Immobilized Nucleic Acid and Electron-Transfer Devices and Methods Employing the Same."
7. U.S.S.N. 08/743,798, filed November 5, 1996, Kayyem et al., entitled "Electrodes Linked via Conductive Oligomers to Nucleic Acids."
8. U.S.S.N. 08/808,750, filed February 28, 1997, Meade et al., entitled "Metallic Solid Supports Modified with Nucleic Acids."

In addition, the applicants note that there are several pending applications which are continuing applications of Meade et al., U.S. Patent No. 5,591,578, reference CC of the PTO form 1449. These applications are U.S.S.N.s 08/709,265, filed September 6, 1996, 08/709,263, filed September 6, 1996, and 08/946,679, filed on October 8, 1997. The

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specifications of these three applications are identical to the specification of the Meade et al. '578 patent.

Finally, the applicants note that there are several copending applications based on United States Serial No. 08/743,798, cited as number 8 above; these are United States Serial Nos. 08/873,978, filed June 12, 1997, 08/911,085, filed August 14, 1997, and 08/889,510, filed July 24, 1997.

An International Search report has now been received in PCT/US97/09739, which is the PCT application corresponding to United States Serial No. 08/659,987, cited as number 4 above. Enclosed herewith is the Search Report, together with copies of the cited documents which appearing as items OO-QQ and 101-102, on the enclosed form PTO-1449. These documents are believed relevant, if at all, for the reasons stated either in the Search Report or the specification itself.

None of the foregoing references are believed to disclose the invention as claimed. Nothing herein shall constitute an admission concerning the contents of any of the cited references, nor shall the inclusion of a reference herein be considered an admission that the reference constitutes prior art against the invention claimed in the above-identified application. Submission of the present document shall not be construed as an admission that a search has been made or that better art does not exist.

While no fee is currently believed to be due, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit

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Account No. 06-1300 (Our Order No. A-64558-1/RFT/RMS). An additional copy of this Information Disclosure Statement is enclosed.

Respectfully submitted,

FLEHR, HOHBACH, TEST,  
ALBRITTON & HERBERT

Dated: January 23, 1998

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Respn to Int'l Search due 12/16/97 PATENT COOPERATION TREATY

Review Foreign Refs (U.S.) 11/16/97  
-58762-1 to -6 cal. 10/8/978mp

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

To:  
FLEHR, HOHBACH, TEST,  
ALBRITTON & HERBERT  
Attn. TRECARTIN, Richard F.  
4 Embarcadero Center  
Suite 3400  
SAN FRANCISCO, CA 94111-4187  
UNITED STATES OF AMERICA

RECEIVED

SEARCHED

NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL SEARCH REPORT  
OR THE DECLARATION

(PCT Rule 44.1)

Date of mailing  
(day/month/year)

06-10-1997

Applicant's or agent's file reference  
FP58762-3/R5 RFT/RMS ✓SMP

FOR FURTHER ACTION See paragraphs 1 and 4 below

International application No.

International filing date

PCT/US 97/09739 ✓

(day/month/year) 04/06/1997

Applicant

CALIFORNIA INSTITUTE OF TECHNOLOGY

1.  The applicant is hereby notified that the International Search Report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the International Application (see Rule 46):

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the International Search Report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland  
Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2.  The applicant is hereby notified that no International Search Report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3.  With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. Further action(s): The applicant is reminded of the following:

Shortly after 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

Within 19 months from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within 20 months from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected in the demand or in a later election within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the International Searching Authority  
  
European Patent Office, P.B. 5818 Patentlaan 2  
NL-2280 HV Rijswijk  
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,  
Fax: (+31-70) 340-3016

Authorized officer

Mirella Deleye-Milan

## PATENT COOPERATION TREATY

## PCT

## INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

|  |   |   |
|--|---|---|
| Applicant's or agent's file reference<br>FP58762-3/RS  | <b>FOR FURTHER ACTION</b> see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below. |   |
| International application No.<br>PCT/US 97/09739       | International filing date (day/month/year)<br>04/06/1997  | (Earliest) Priority Date (day/month/year)<br>07/06/1996 |
| Applicant<br><b>CALIFORNIA INSTITUTE OF TECHNOLOGY</b> |   |   |

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 3 sheets.

It is also accompanied by a copy of each prior art document cited in this report.

1.  Certain claims were found unsearchable (see Box I).
2.  Unity of invention is lacking (see Box II).
3.  The international application contains disclosure of a nucleotide and/or amino acid sequence listing and the international search was carried out on the basis of the sequence listing
  - filed with the international application.
  - furnished by the applicant separately from the international application,
    - but not accompanied by a statement to the effect that it did not include matter going beyond the disclosure in the international application as filed.
  - Transcribed by this Authority
4. With regard to the title,
  - the text is approved as submitted by the applicant.
  - the text has been established by this Authority to read as follows:
5. With regard to the abstract,
  - the text is approved as submitted by the applicant.
  - the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this International Search Report, submit comments to this Authority.
6. The figure of the drawings to be published with the abstract is:
 

Figure No. \_\_\_\_\_

  - as suggested by the applicant.
  - because the applicant failed to suggest a figure.
  - because this figure better characterizes the invention.

None of the figures.

## INTERNATIONAL SEARCH REPORT

International Application No

PCT/US 97/09739

A. CLASSIFICATION OF SUBJECT MATTER  
 IPC 6 C07H19/067 C07H19/167 C07H21/02 C07H23/00 C12Q1/68

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)  
 IPC 6 C07H C12Q

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

| Category <sup>a</sup> | Citation of document, with indication, where appropriate, of the relevant passages   | Relevant to claim No. |
|-----------------------|--|-----------------------|
| X ✓                   | C. J. MURPHY ET AL: "Long-range photoinduced electron transfer through a DNA helix."<br>SCIENCE., vol. 262, 12 November 1993, LANCASTER, PA US,<br>pages 1025-1029, XP002041920<br>see the whole document<br>---   | 1-32                  |
| X                     | JOHNSTON D H ET AL:<br>"TRANS-DIOXORHENIUM(V)-MEDIATED ELECTROCATALYTIC OXIDATION OF DNA AT INDIUM TIN-OXIDE ELECTRODES: VOLTAMMETRIC DETECTION OF DNA CLEAVAGE IN SOLUTION"<br>INORGANIC CHEMISTRY, vol. 33, no. 26, 21 December 1994,<br>pages 6388-6390, XP000196454<br>see the whole document<br>--- | 1-32                  |
|                       | -/-  |                       |

 Further documents are listed in the continuation of box C. Patent family members are listed in annex.

## \* Special categories of cited documents :

- \*A\* document defining the general state of the art which is not considered to be of particular relevance
- \*E\* earlier document but published on or after the international filing date
- \*L\* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- \*O\* document referring to an oral disclosure, use, exhibition or other means
- \*P\* document published prior to the international filing date but later than the priority date claimed

\*T\* later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

\*X\* document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

\*Y\* document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

\*&\* document member of the same patent family

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Date of the actual completion of the international search Date of mailing of the international search report

30 September 1997

06-10-1997

## Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2  
 NL - 2280 HV Rijswijk  
 Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,  
 Fax: (+31-70) 340-3016

## Authorized officer

Moreno, C

## INTERNATIONAL SEARCH REPORT

International Application No

PCT/US 97/09739

## C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

| Category * | Citation of document, with indication, where appropriate, of the relevant passages   | Relevant to claim No.            |
|------------|--|----------------------------------|
| X          | CARTER M T ET AL: "VOLTAMMETRIC STUDIES OF THE INTERACTION OF METAL CHELATES WITH DNA 2. TRIS-CHELATED COMPLEXES OF COBALT(III) AND IRON(II) WITH 1,10-PHENANTHROLINE AND 2,2'-BIPYRIDINE" JOURNAL OF THE AMERICAN CHEMICAL SOCIETY, vol. 111, 1989, pages 8901-8911, XP002015359<br>see the whole document<br>--- | 1-32                             |
| X          | WO 90 05732 A (UNIV COLUMBIA) 31 May 1990<br>see the whole document<br>---   | 1-32                             |
| X ✓        | WO 95 15971 A (CALIFORNIA INST OF TECHN)<br>15 June 1995<br>see the whole document<br>---  | 1-32                             |
| P,X        | WO 97 01646 A (UNIV NORTH CAROLINA ;THORP H HOLDEN (US); JOHNSTON DEAN H (US)) 16 January 1997<br>see the whole document<br>---  | 1-32                             |
| A          | WO 93 23425 A (ONTARIO CANCER INST) 25 November 1993<br><br>see the whole document<br>---  | 1,4-6,<br>11,<br>18-20,<br>27-30 |
| A          | PATENT ABSTRACTS OF JAPAN<br>vol. 013, no. 039 (C-563), 27 January 1989<br>& JP 63 238166 A (MITSUBISHI ELECTRIC CORP), 4 October 1988,<br>see abstract<br>---   | 1,4-6,<br>11,<br>18-20,<br>27-30 |
| A          | N. J. TURRO ET AL: "Photoelectron transfer between molecules adsorbed in restricted spaces." PHOTOCHEM. CONVERS. STORAGE SOL. ENERGY, PROC. INT. CONF. 8TH, 1990,<br>pages 121-139, XP002041921<br>see the whole document<br>-----   | 1,4-6,<br>11,<br>18-20,<br>27-30 |

## INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/US 97/09739

| Patent document cited in search report | Publication date | Patent family member(s) |  | Publication date |
|--|------------------|-------------------------|--|------------------|
| WO 9005732 A                           | 31-05-90         | US 5112974 A            |  | 12-05-92         |
|  |                  | AU 4647689 A            |  | 12-06-90         |
|  |                  | CA 2002380 A            |  | 07-05-90         |
|  |                  | US 5439794 A            |  | 08-08-95         |
| WO 9515971 A                           | 15-06-95         | US 5591578 A            |  | 07-01-97         |
|  |                  | AU 1215295 A            |  | 27-06-95         |
|  |                  | CA 2178618 A            |  | 15-06-95         |
|  |                  | EP 0733058 A            |  | 25-09-96         |
| WO 9701646 A                           | 16-01-97         | AU 6337696 A            |  | 30-01-97         |
| WO 9323425 A                           | 25-11-93         | CA 2094785 A            |  | 09-11-93         |

## NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule", and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions respectively.

### INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

#### What parts of the international application may be amended?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

#### When?

Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

#### Where not to file the amendments?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

#### How?

Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

**The amendments must be made in the language in which the international application is to be published.**

#### What documents must/may accompany the amendments?

**Letter (Section 205(b)):**

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

**The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.**

## NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

**The following examples illustrate the manner in which amendments must be explained in the accompanying letter:**

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:  
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:  
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:  
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or  
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:  
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

### "Statement under article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

**It must be in the language in which the international application is to be published.**

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

### Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

### Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, where upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.